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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,673	12/04/2003	Ronald W. Kolb	20030403.ORI	8471
23595 7590 03/02/2007 NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			EXAMINER REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/02/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/727,673

Applicant(s)

KOLB, RONALD W.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 4/27/2005.

- Claims 1, 3, and 7 were amended.
- Claims 1-9 are pending.
- Replacement Drawings were filed for entry.

Drawings

[1] The drawing(s) were previously objected for informalities. In view of Applicant's replacement drawing(s) submitted on 5/12/2005, all previous objection(s) to the drawings have been withdrawn. Accordingly, the replacement drawings have been entered.

Claim Objections

[2] Claim(s) 1 and 7 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 4/27/2005. Accordingly, the objection(s) to the claim(s) 1 and 7 have been withdrawn.

Claim Rejections - 35 USC § 102

[3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

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application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Thompson, US-2,811,024, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Thompson is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Thompson discloses of a ring (see figure below) comprising:

(a) a band (1);

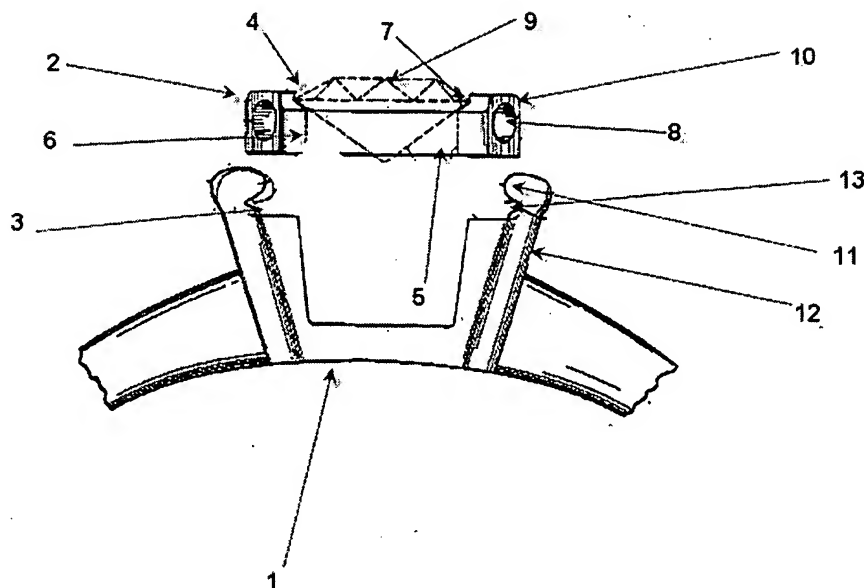
(b) a hollow bezel (2) secured to a first portion (3) of said band (1) and having an open top (4), and open bottom (5), an inside wall (6) defining a lumen extending between said open top (4) and said open bottom (5), a seat (7) within said lumen (6), and an outside wall (10) having an exterior recessed section (8);

(c) a stone (9) mounted at least partially within said lumen (6) of said bezel (2) and in contact with said seat (7); and

(d) a hook (11) at a second portion (12) of said band (7) and having an opening (13) sized to receive the recessed section (8) of said bezel (2) to clasp the two portions (3, 12) of the band (1) together, wherein when said hook (11) has received the recessed section (8) of said bezel (2), the hook (11) is impeded from detaching from the bezel (2) by either the top or bottom of said

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bezel (2) (it would take force to detach the bezel, so therefore it is considered “impeded” from detaching from said bezel).



Re: Claim 3, wherein said band (1) has spring characteristics (part 3, line 64, stating, “In the initial position...toward the center of the head just far enough to be sprung slightly outwardly as...”)) such that the band (1), hook (11) and bezel (2) all cooperate to hold the inside of the hook (11) against the exterior recessed section (8) of the bezel (2) as the piece of jewelry is worn.

Re: Claim 5, wherein the outside wall (10, including that of 8) of said bezel (2) has a substantially hour-glass shape (due to the “concave exposed area in which is formed a socket” represented by 8; the concavity of the socket gives the outside wall a hour-glass shape).

Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Thompson discloses the claimed invention except for stating that the band holding the bezel comprises at least one metal wire. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create an embodiment of ring that was comprised of metal wire, as well as obvious to change the medium for holding the clasp to that of a bracelet, necklace, etc, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

[7] Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Thompson discloses the claimed invention except for stating that the band holding the bezel comprises of at least one metal wire, including spring characteristics approximately between 5 and 7 dies hard. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create an embodiment of ring that was comprised of a metal wire, specifically one in which the spring characteristics are approximately between 5 and 7 dies hard, as it is obvious to change the spring characteristics of a material in order to achieve a desired spring resiliency for a preferred application of the spring. It is also obvious for the medium for holding the clasp to that of a bracelet, necklace, etc, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

[8] Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024 in view of Guild, 755,654.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Thompson teaches of a bezel setting in a ring as described in the above claims.

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However, Thompson fails to disclose expressly that the bezel consists of seat beads helping to retain the jewel.

Guild teaches of a jewel setting possessing a bur (e) and bead (f) in Figs. 3 and 4 whose purpose serve according to part 2, line 5, "forming a bur which will serve to retain a jewel (d) in position in its setting," which happens to contact the jewel from above.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the bezel taught by Thompson, to suggest an embodiment utilizing a bur or bead as taught by Guild, in order to, as Guild stated above, to help retain a jewel in position in its setting.

Now as for Claim 6, Thompson teaches of a ring, further including a pair of recesses above the seat (7), a seat bead (Thompson in view of (e) from Fig. 3 or 4 of Guild) positioned within each of said recesses (7) such that the edge of the stone (9) is held in place between said seat beads and said seat (edge of stone 9 is between seat, 7, and seat beads from above in the recess in Fig. 3 of Thompson).

Now as for Claim 7, Thompson teaches of a ring (see figure above) comprising:

(a) a band (1) having first (3) and second portions (12);

(b) a bezel (2) secured to said first end (3) of said band (1), said bezel (2) having an outside wall (10) comprising a top section, a bottom section and a recessed center section (5), an open top (4), an open bottom (5), and an inside wall (6) defining a lumen extending between said open top(4) and said open bottom (5), and a lumen wall (6) having a seat (7), and at least one recess (7).

(c) a hook (11) formed at said second end (12) of the band (1);

(d) a stone (9) positioned at least partially within said lumen (6) of said bezel (2) and in contact with said seat (7); and

(e) a seat bead (Thompson in view of (e) from Fig. 3 or 4 of Guild) positioned within said recess (7) cooperating with said seat (7) to hold said stone (9) to said bezel (2),

wherein said hook (11) receives said recessed center section (8) of said bezel (2) to secure said first (3) and second portions (12) of said band together (via bezel, 2).

[9] Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, US-2,811,024.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S. P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made patentable. In re Klug, 333 F2d 905, 142 U.S. P.Q. 161 (CCPA 1964). Further, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 8 and 9 refer structurally to that of claims 1 and 7, which have been rejected for the above reasons (see 102 and 103 rejections). Claims 8 and 9 are thus rejected due to the

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reasoning of the above paragraph. In addition, the method of using a lost wax casting process is not novel as Marticorena (US-3,601,178), Michaud (US-4,392,289), and others familiar in the art, teach of such a technique.

Response to Arguments

[10] Applicant's arguments filed 4/27/2005 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. In the instant case, the examiner maintains that the amended subject matter as presented in independent claims 1 and 7 are still anticipated by the prior art of Thompson. As can be seen above, the examiner has provided a figure to help describe how the amended claims still read onto that presented by Thompson. The examiner would like to point out that it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Further, applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974), and that things clearly shown in reference patent drawings qualify as prior art features, even though they may be unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972). Thus, as shown above, the examiner maintains that the current amendment to the claims including the limitations of "an exterior recessed section"; "clasp the two ends of the band together"; and "hook is impeded from detaching from the bezel" are still anticipated by Thompson as further depicted and explained above.

[11] Applicant's arguments filed 4/27/2005 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. To begin, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the

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language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.” Applicant has failed to specifically point out how language of the claims patentably distinguishes them from the references including that of Thompson. The applicant primarily discusses features of Thompson, and how Thompson does not “teach, suggest, or provide an incentive for a modification of the prior art to make the claimed Stone Mount and Clasp for Jewelry found in the present invention” (page 10 of remarks). In response to Applicant’s argument that there is no suggestion to modify the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

It is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a prima facie case of obviousness. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). Moreover, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). The test

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for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

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Conclusion

[12] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

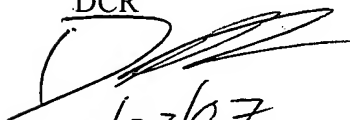
[13] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese
Assistant Examiner
Art Unit 3677

DCR



2/27/07



ROBERT J. SANDY
PRIMARY EXAMINER

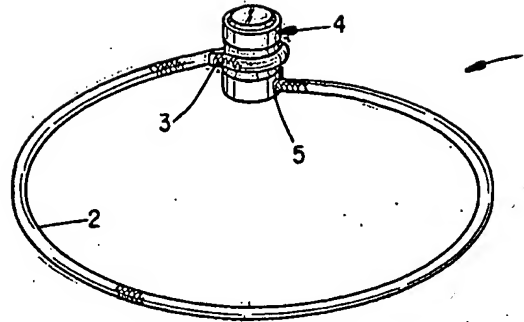


FIG. 1

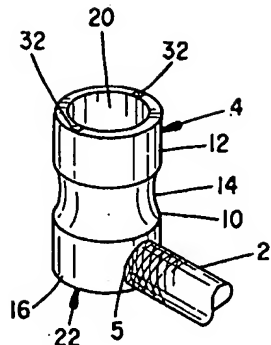


FIG. 2

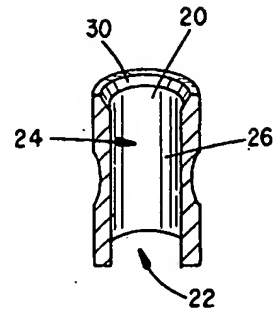


FIG. 3

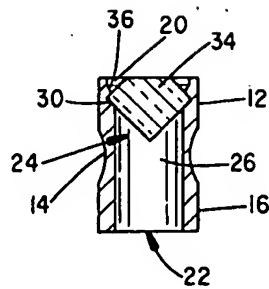


FIG. 4

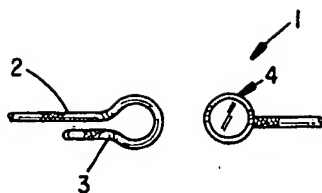


FIG. 5A

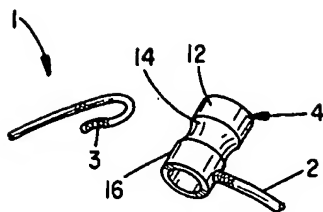


FIG. 5B

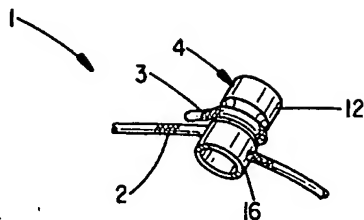


FIG. 5C